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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,955	04/25/2000	Yvonne E. Penfold	IMIN.P-027	8900

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EXAMINER

DUFFY, PATRICIA ANN

ART UNIT PAPER NUMBER

1645

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/557,955

Applicant(s)

PENFOLD ET AL.

Examiner

Patricia A. Duffy

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 03 October 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 12-20.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 2-11.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

*Patricia A. Duffy*  
Patricia A. Duffy  
Primary Examiner  
Art Unit: 1645

Continuation of 2. NOTE: As previously indicated the recitations of claims 5, 10 and 11 were not viewed to limit the improvement and as such, Applicants amendments to now indicate that they are an improvement requires a new search. Prosecution history as set forth in the final rejection, clearly indicated that these were not viewed as limitations or improvements because they were directed to the preamble and the preamble of a Jepsom claim is a general description of all the elements or steps of the claimed combination that are conventional or known. As such, these elements were not given weight, because they were "conventional or known". Additionally, the amendment of claim 5 clearly provides for a different second set of direct particulat label. However, this renders dependent claims 6, 7 and 8 confusing because it is unclear as to what population "the direct particulate label" modifies, because there are now two populations. Further, the amendment still does not comply with 37 CFR 1.75(e). Additionally, the amendment of claims 5, 10 and 11 is improper and provides confusion because the preamble of a Jepsom claim is admitted prior art, yet Applicants seek to redefine the preamble as an improvement. As such, it is not clear as to what Applicants consider their improvement and what is admitted prior art. Applicants are directed to 37 CFR 1.75(e) for guidance which states: "Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

- (1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,
- (2) A phrase such as "wherein the improvement comprises," and
- (3) Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

Therefore, Applicants proposed amendments would require new rejections due to the confusing nature of the amendments, new consideration and new search. Applicants amendments do not simplify the issues for appeal and are not entered..

Continuation of 5. does NOT place the application in condition for allowance because: the amendment is not entered. Applicants indicate that the examiner requested the entry. There is no request for such articulated in the final office action. Entry of amendments after final is governed by 37 CFR 1.116 and must not raise, new considerations, new issues or new search. The response is moot in veiw of the non-entry of the amendments. All rejections are maintained for reasons made of record.